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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MICHAEL G. LEE and LESLIE D. OWENS

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Appeal 2008-1206  
Application 09/865,667  
Technology Center 2100

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Decided: September 17, 2008

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Before JAMES D. THOMAS, HOWARD B. BLANKENSHIP,  
and ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-12. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

## THE INVENTION

The disclosed invention relates generally to information security and cryptography. More specifically, certain embodiments relate to a technique for enabling a firewall device to allow encrypted data to securely pass between networks, and at the same time allow the firewall to selectively monitor the encrypted traffic that is allowed to pass. (Spec. 1).

Independent claim 1 is illustrative:

1. A method for enabling a firewall to securely pass encrypted data, the method comprising:

detecting an exchange of a first encryption key between a host device and a remote device, wherein the first encryption key supports confidentiality protection of first data exchanged between the host device and the remote device according to a first security policy;

exchanging a second encryption key with the host device when the exchange of the first encryption key is detected, wherein the exchange of the second encryption supports confidentiality protection of second data exchanged between the firewall and the host device according to the second security policy;

requesting at the firewall, based at least in part upon the second security policy, the first encryption key from the host device; wherein the first encryption key is sent under the protection of the second encryption key and in accordance with the second security policy; and

passing encrypted data when it is determined that the first encryption key is received.

### THE REFERENCES

The Examiner relies upon the following references as evidence in support of the rejections:

Ylonen	US 6,438,612 B1	Aug. 20, 2002 (filed Sep. 11, 1998)
Perlman	US 6,546,486 B1	Apr. 8, 2003 (filed Feb. 23, 2000)

### THE REJECTIONS

1. Claims 1, 2, 4-8, and 10-12 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Perlman.
2. Claims 3 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Perlman in view of Ylonen.

### PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted). “Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art”) (internal citations omitted).

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740.

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellants’ Briefs to show error in the proffered *prima facie* case.

Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

#### CLAIM GROUPING

When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.

37 C.F.R. § 41.37(c)(1)(vii) (2006).<sup>1</sup>

Regarding the anticipation rejection of claims 1, 4, 5, 7, 10, and 11, Appellants argue these claims as a single group that stand rejected as being anticipated by Perlman (App. Br. 14-16). We select independent claim 1 as the representative claim on which to decide the appeal of all the claims in this group.

Regarding the anticipation rejection of claims 6, 8, and 12, Appellants argue these claims as a single group that stand rejected as being anticipated by Perlman (App. Br. 16). We select dependent claim 8 as the representative claim on which to decide the appeal of all the claims in this group.

Regarding the obviousness rejection of claims 3 and 9, Appellants argue these claims as a single group that stand rejected as being unpatentable over Perlman and Ylonen (App. Br. 17-20). We select independent claim 3 as the representative claim on which to decide the appeal of all the claims in this group.

We consider the anticipation rejection of dependent claim 2 separately, as argued by Appellants in the Brief (App. Br. 16).

#### Findings of Fact

The following findings of fact are supported by a preponderance of the evidence.

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<sup>1</sup> We cite to the version of the Code of Federal Regulations in effect at the time of the Appeal Brief. The current version includes the same rules.

1. Perlman discloses a source 102 sending a message 202 to a destination 110. (Col. 5 ll. 40-42).
2. Perlman discloses that the message is encrypted with a message key 204. The message key 204 is used to form an encrypted message key 306. (Col. 5 ll. 44-48).
3. Perlman discloses that the source 102 sends encrypted data (message 208) and an encrypted message key to destination 110 through a firewall 106. (Col. 5 ll. 55-56).
4. Perlman discloses returning the message key 204 in a “secure manner,” in which the message key 204 is encrypted with a firewall public key. (Col. 5, ll. 66-67).

#### Claims 1, 4, 5, 7, 10, and 11

We consider the Examiner’s rejection of representative claim 1. Appellants contend that Perlman fails to disclose the limitations of “detecting an exchange of a first encryption key between a host device and a remote device,” and “exchanging a second encryption key with the host device,” as recited in claim 1. (App. Br. 13).

#### Claim Construction

During prosecution, “the PTO gives claims their ‘broadest reasonable interpretation.’” *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)).

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Here, we note that the step of “detecting an exchange of a first encryption key between a host device and a remote device,” as recited in claim 1, does not define where the detection step occurs, which element or entity performs the detecting, or how the detection is accomplished. Thus, under the broadest reasonable interpretation, we construe this limitation to encompass that the detection of an exchange may occur in the host, remote host, or firewall, and the “detection” triggers the exchange of the second encryption key with the host device.

Appellants contend that the Examiner’s proffered first key i.e., Perlman’s key 204, is not detected, rather it is passed to the destination 110 for decryption at the destination. (Reply Br. 13). Therefore, according to Appellants, even if the public key disclosed by Perlman is the claimed “second key” then Perlman fails to disclose the claimed features of the first key. (*Id.*). We disagree.

As noted by the Examiner, Perlman teaches that key 204 is sent between the source 102 and destination 110. (FF 1-3). In addition, Perlman discloses that the “exchange” occurs because key 204 (first key) is negotiated between the source 102 and destination 110. (Col. 6 ll. 9-11). Further, we find that Perlman teaches that, after the exchange, key 204 is used to encrypt message 208. (Col. 6 ll. 15-17).

In accordance with our claim construction discussed above, Perlman discloses that the exchange of key 204 triggers the negotiated message key 204 and security association 210 to be sent to firewall 106 “in a secure manner” by the source (host) (col. 6, ll. 11-14). The “secure manner” in which the message key 204 and security association 210 are sent to the



firewall 106, comprises encrypting the message key 204 with a firewall public key (second encryption key). (FF 4).

Thus, Perlman discloses the exchange of the (first) encryption key 204 between the source 102 (host) and the destination (110) (i.e., remote device), and this exchange triggers (detection) the public firewall key (second encryption key) to be exchanged between the source 102 (host) and firewall 106. Therefore, we find Perlman discloses the argued limitations of “detecting an exchange of a first encryption key between a host device and a remote device,” and “exchanging a second encryption key with the host device,” as claimed. (Claim 1) (*see also* App. Br. 13).

Based on the record before us, we conclude that Appellants have not shown error in the Examiner’s prima facie case of anticipation. Accordingly, we sustain the Examiner’s rejection of claim 1 (and claims 4, 5, 7, 10, and 11 which fall therewith) as being anticipated by Perlman.

## Claim 2

We consider next the Examiner’s rejection of claim 2 as being anticipated by Perlman. Appellants contend that claim 2 is allowable by virtue of its dependency upon claim 1 (App. Br. 16).

In response, we find no deficiencies with the Examiner’s rejection of claim 1, as discussed *supra*.

Appellants further merely recite the language of claim 2, without providing any meaningful analysis regarding the patentability of claim 2. (App. Br. 16).

In response, we note that a statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. *See* 37 C.F.R. § 41.37(c)(vii); *see also* 37 C.F.R. § 1.111(b).

Based upon our review of the record before us, we conclude that Appellants have not met their burden of showing specific error in the Examiner's findings of fact. Accordingly, we sustain the rejection of claim 2 as being anticipated by Perlman.

#### Claims 6, 8, and 12

We consider next the Examiner's rejection of representative claim 8, as being anticipated by Perlman.

Appellants contend that claim 8 is allowable by virtue of its dependency upon claim 7 (App. Br. 16).

In response, we find no deficiencies with the Examiner's rejection of claim 7, as discussed *supra*.

Appellants again merely recite the language of claim 8, without providing any meaningful analysis regarding the patentability of claim 8. (App. Br. 16). Because Appellants have not met their burden of showing that the Examiner erred, we sustain the Examiner's rejection of representative claim 8 (and claims 6 and 12 that fall therewith) as being anticipated by Perlman.

Obviousness under 35 U.S.C. § 103(a)

Claims 3 and 9

We consider next the obviousness rejection of representative claim 3 as being unpatentable over Perlman and Ylonen.

Appellants essentially contend that Ylonen fails to cure the deficiencies of Perlman. (App. Br. 18-19). Thus, the patentability of claim 3 is urged based upon Appellants' arguments regarding the patentability of claim 1 discussed *supra*, which we did not find to be persuasive.

Further, Appellants again merely state the limitations of claim 3 without providing any meaningful analysis regarding the distinctions between claim 3 and the Examiner's proffered combination of Perlman and Ylonen. (App. Br. 19). Because Appellants have not met their burden of showing the Examiner erred, we sustain the rejection of representative claim 3 (and claim 9 that falls therewith) as being unpatentable over Perlman and Ylonen.

Reply Brief

We note that the Reply Brief is properly used to respond to points of argument raised by the Examiner in the Answer and not as a means for presenting new arguments. *See Optivus Tech., Inc. v. Ion Beam Applications S.A.*, 469 F.3d 978, 989 (Fed. Cir. 2006) (an issue not raised in an opening brief is waived). While we have fully considered Appellants' responses in the Reply Brief, we decline to address any new arguments not originally presented in the principal Brief.

### CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have not met their burden of showing that the Examiner erred in rejecting claims 1, 2, 4-8, and 10-12 under 35 U.S.C. § 102(e) for anticipation. We further conclude that Appellants have not met their burden of showing that the Examiner erred in rejecting claims 3 and 9 under 35 U.S.C. § 103(a) for obviousness.

### DECISION

We affirm the Examiner's decision rejecting claims 1-12. Therefore, claims 1-12 are not patentable.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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